

REMARKS:

In response to the Office Action mailed March 4, 2009, reconsideration of the present application is respectfully requested for the reasons that follow.

Claims 1 and 2 have been amended and claim 13 has been canceled. Thus the claims for consideration are claims 1-9, 14-19 and 21.

As an initial matter, Applicants note that the Examiner indicated that he did not consider the references listed in the specification and that this is not a proper format for an Information Disclosure Statement (IDS). An IDS for this case has been filed and the Examiner did indicate on the form that the references submitted, including those listed in the specification, in the IDS were considered. Applicants are unclear why the Examiner made this comment regarding the references in the specification and request that the Examiner clarify this statement in the next Office Action.

Claim Rejections – 35 USC §112

Claims 1-9, 13-19 and 21 were pending in the application. The Examiner indicated that claim 13 is subject to election or restriction. Claim 13 was directed to the group "IIH" which was subject to the original Restriction Requirement, and, therefore, claim 13 is directed to non-elected subject matter. As noted above, claim 13 has been cancelled and, therefore, this objection has been obviated.

The Examiner has rejected claims 1-9, 14-19 and 21 under 35 U.S.C. § 112, first paragraph, for lack of enablement. The Examiner argues that the claims are enabled only when R7 and R8 are non-heterocyclic groups. The Examiner argues that the claims are not enabled when R7 and R8 together with the nitrogen to which they are attached from a saturated or unsaturated 3- to 7-membered heterocycle. The Examiner argues that the specification does not enable one of skill in the art to make and use the invention commensurate in scope with the claims. Applicants disagree with the Examiner's argument, however, in the interest of expediting prosecution, claim 1 has been amended to delete the element where R7 and R8 together with the nitrogen atom to which they are attached form a saturated or unsaturated 3 to 7-membered nitrogen heterocycle. Therefore, this rejection has been obviated and should be withdrawn.

The Examiner has rejected claims 1-9, 14-19 and 21 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. The Examiner argues that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor had possession of the claimed invention at the time of the filing of the patent application. The Examiner argues further that the specification describes a genus of chemical compounds and has adequately described some of the compounds contained in the genus. However, the Examiner argues that the specification does not describe a sufficient number of compounds to be representative of the compounds in the genus and that, therefore, the entire genus of compounds lacks written description support.

Finally, the Examiner argues that the specification does not provide a readily apparent combination of identifying characteristics which could identify the compounds contained within the genus.

Applicants disagree with the Examiner's arguments and conclusions. Regardless of what is disclosed in the specification, one of skill in the art at the time of the filing of the present application would know what characteristics to consider in identifying compounds in the claimed genus. US Pat No. 6,849,618 ('618 patent) which belongs to the patent family of WO 02/83459, is directed to uracil substituted phenyl sulfamoyl carboxamides which have herbicidal activity. While other portions of the chemical structure in the '618 patent are different than the presently claimed compounds, it will be noted that in the phenyl group the '618 patent teaches the desirability of substituents that are also in the present claims. Specifically, the '618 patent discloses that "[w]hen the terms phenyl or benzyl are designated as being optionally substituted, the substituents which are optionally present may be any one or more of those customarily employed in the development of pesticidal compounds and/or the modification of such compounds to influence their structure/activity, persistence, penetration or other property." (col. 8, ll. 40-45). The '618 patent then describes that the phenyl group should be substituted with, for example, a heterocycle (identical to groups II-A thru II-D in claim 1), a halogen (identical to groups R² and R³ in claim 1), an alkyl or alkoxy (identical to groups R⁴ thru R⁸ in claim 1) and so on. Therefore, it is clear that one of skill in the art knew, at the time of the filing of the present application, what structural features were

particularly useful in modifying a core compound to give it herbicidal activity. Furthermore, the present specification describes hundreds of individual, specific compounds (see for example Table 1) as well as a genus and subgenus of compounds. As a result, one of skill in the art would conclude that the Applicants had possession of the entire scope of compounds that are the subject matter of the present claims. Therefore, this written description rejection is improper and should be withdrawn.

The Examiner has rejected claims 1-9, 14-19 and 21 under 35 U.S.C. § 112, first paragraph, as being indefinite for including "II-A to II-H" in the definition of R1 in claim 1. Claim elements II-E to II-H refer to non-elected subject matter as a result of the Restriction Requirement. Claim 1 has also been amended to remove groups II-E to II-H. Claim 1 has also been amended to remove R22 and R23, which are radicals attached to the deleted radical II-E , and to remove R24 to R27 and A1 to A4, which are radicals attached to the deleted radical II-F to II-H. The Examiner also points out that in claim 2 a typographical error including "10" appears. Claim 2 has been amended to remove this typographical error. Therefore, these rejections have been obviated and should be withdrawn.

In view of the foregoing remarks, Applicants respectfully request withdrawal of the outstanding Office Action rejection. Early and favorable action is awaited. The Director is authorized to charge any fees or overpayment to Deposit Account No. 02-2135.

Respectfully submitted,

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